



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of  
Zhang *et al.*

Patent No.: 6,194,191

Date of Issuance: February 27, 2001

For: METHOD FOR THE PRODUCTION AND  
PURIFICATION OF ADENOVIRAL  
VECTORS

Serial No.: 08/975,519

Filed: November 20, 1997

Group Art Unit: 1643

Examiner: Mary E. Mosher

Atty. Dkt. No.: INRP:058

#25  
Commissioner  
Papers  
7.11.03  
PATENT

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FEB 12 2003  
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FEB 10 2003  
OFFICE OF PETITIONS

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37 C.F.R. 1.8

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*[Signature]*  
Signature

**PETITION TO CORRECT INVENTORSHIP IN  
ISSUED PATENT UNDER 37 C.F.R. § 1.324**

Commissioner for Patents  
Washington, DC 20231

Sir:

The Assignee of U.S. Patent No. 6,194,191 hereby petitions under 37 C.F.R. § 1.324 for correction of an error in the inventorship of said patent by the addition of Deborah Wilson and Lucetta Caston as inventors. The error in omitting Deborah Wilson and Lucetta Caston as inventors of U.S. Patent No. 6,194,191 arose without any deceptive intent on the part of the omitted inventors. In accordance with 37 C.F.R. §1.324(b)(1-4), the following items have been submitted herewith in support of the instant petition:

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130.00 EP

(1) Statements by Deborah Wilson and Lucetta Caston under 37 C.F.R. §1.324(b)(1), stating that the inventorship error corrected herein occurred without any deceptive intention on their part. No other inventors have been added or deleted herein (Appendix A).

(2) Statements made pursuant to 37 C.F.R. §1.324(b)(2) by the current named inventors in U.S. Patent No. 5,658,730 who have joined the case and have not submitted a statement under 37 C.F.R. §1.324(b)(1): Shuyuan Zhang, Capucine Thwin, and Zheng Wu. The statement indicates no disagreement with the change of inventorship requested herein (Appendix B).

A statement from Toohyon Cho has not been submitted herewith. Pursuant to 37 C.F.R. § 1.47(a), Dr. Cho has not joined the application and thus is not a party to the application under 35 U.S.C. § 256. The assignee has subsumed the role of the inventor for purposes of the instant petition. As set forth in 35 U.S.C. § 118, whenever an inventor refuses to execute an application for patent, the assignee of the inventor may "make application for patent *on behalf of and as agent for* the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage..." (emphasis added) Proof of such pertinent facts and a showing that the action is necessary have previously been established, as evidenced by the decision of the Office of Petitions mailed February 26, 1999 according Rule 1.47(a) status in the instant case. A copy of the decision is included herewith at Appendix B.

With the decision according Rule 1.47(a) status, Dr. Cho was notified by the Office of Petitions of the opportunity to join the application and file an oath or declaration as required under 37 C.F.R. §1.63. No such action has been taken. Petitioner further sent a copy of the

statement under 37 C.F.R. §1.324(b)(2) by certified mail to Dr. Cho's last known address as follows:

Dr. Toohyon Cho  
3600 Chestnut St., Apt. 311  
Philadelphia, PA 19104-6106

The package was returned unopened, marked by the U.S. Postal Service as "Return to Sender," and "attempted not known." Dr. Cho has not joined the instant application and is not a party thereto. The instant Petition has been made on behalf of all parties and assignees under 35 U.S.C. §256.

(3) A statement by the Assignee Introgen Therapeutics, Inc. under 37 C.F.R. §1.324(b)(3), agreeing to the change of inventorship in the patent, which statement complies with 37 C.F.R. §3.73(b) (Appendix C).

(4) A check in the amount of \$130.00 as the petition fee under 37 C.F.R. §1.20(b).

In view of the foregoing comments, it is submitted that all the requirements for correction of the instant patent have been satisfied. Issuance of a certificate naming only the actual inventors of the patent is thus respectfully requested.

Respectfully submitted,



Robert E. Hanson  
Reg. No. 42,628  
Attorney for Petitioner

FULBRIGHT & JAWORSKI  
600 Congress Avenue, Suite 1900  
Austin, TX 78701  
(512)536-3000

Date: January 29, 2003

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Examiner: Mary E. Mosher

Atty. Dkt. No.: INRP:058

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**FEB 10 2003**

**OFFICE OF PETITIONS**

STATEMENT OF DEBORAH WILSON AND LUCETTA CASTON

We, Deborah Wilson and Lucetta Caston, each hereby state the following:

- (1) I was not originally named as an inventor in U.S. Patent No. 6,194,191.
- (2) The failure to name me as an inventor in U.S. Patent No. 6,194,191 occurred

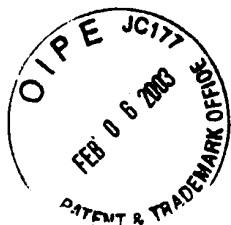
without any deceptive intent on my part.

[Signature]  
Deborah Wilson

7/11/02  
Date

\_\_\_\_\_  
Lucetta Caston

\_\_\_\_\_  
Date



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- (2) The failure to name me as an inventor in U.S. Patent No. 6,194,191 occurred

without any deceptive intent on my part.

\_\_\_\_\_  
Deborah Wilson

\_\_\_\_\_  
Date

Lucetta Caston

Date



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STATEMENT OF SHUYUAN ZHANG, CAPUCINE THWIN,

ZHENG WU AND TOOHYON CHO,

We, Shuyuan Zhang, Capucine Thwin, Zheng Wu and Toohyon Cho, hereby state the following:

(1) We were the inventors named in U.S. Patent No. 6,194,191, issued February 27, 2001.

(2) We have no disagreement in regard to the requested change of inventorship in U.S. Patent No. 6,194,191 constituting the addition of Deborah Wilson and Lucetta Caston as an inventor.

[Signature]  
Shuyuan Zhang

15 July 2002  
Date

\_\_\_\_\_  
Capucine Thwin

\_\_\_\_\_  
Date

\_\_\_\_\_  
Zheng Wu

\_\_\_\_\_  
Date

\_\_\_\_\_  
Toohyon Cho

\_\_\_\_\_  
Date



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\_\_\_\_\_  
Shuyuan Zhang

\_\_\_\_\_  
Date

  
\_\_\_\_\_  
Capucine Thwin

1/9/03  
\_\_\_\_\_  
Date

\_\_\_\_\_  
Zheng Wu

\_\_\_\_\_  
Date

\_\_\_\_\_  
Toohyon Cho

\_\_\_\_\_  
Date



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STATEMENT OF SHUYUAN ZHANG, CAPUCINE THWIN,

ZHENG WU AND TOOHYON CHO,

We, Shuyuan Zhang, Capucine Thwin, Zheng Wu and Toohyon Cho, hereby state the following:

(1) We were the inventors named in U.S. Patent No. 6,194,191, issued February 27, 2001.

(2) We have no disagreement in regard to the requested change of inventorship in U.S. Patent No. 6,194,191 constituting the addition of Deborah Wilson and Lucetta Caston as an inventor.

\_\_\_\_\_  
Shuyuan Zhang

\_\_\_\_\_  
Date

Capucine Thwin



Zheng Wu

Toohyon Cho

Date

12/31/02

Date

Date

AUSTIN

AP  
INRP: 058



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
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OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

ARNOLD WHITE AND DURKEE  
P.O. BOX 4433  
HOUSTON TX 77210-4433

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FEB 26 1999

In re Application of  
Zhang, Thwin, Wu and Cho  
Application No. 08/975,519  
Filed: November 20, 1997  
For: Method for the Production and  
Purification of Adenoviral Vectors

SPECIAL PROGRAMS OFFICE  
DECISION ACCORDING STATUS  
UNDER 37 CFR 1.47(a)

This is in response to the papers filed January 20, 1999 which have been treated as a request for reconsideration of the petition under 37 CFR 1.47(a).

The petition is granted.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

Telephone inquiries regarding this decision should be directed to the undersigned at (703)306-3159.

*Karin Tyson*

Karin Tyson  
Senior Legal Advisor  
Special Program Law Office  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects

*Decision of according status under 37 CFR 1.47(a)*

CHECKED BY:	
1ST CHECK	<i>[Signature]</i>
2ND CHECK	<i>[Signature]</i>



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
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OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

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**FEB 26 1999**

SPECIAL PROGRAMS OFFICE  
DAC FOR PATENTS

Toohyon Cho  
874 Yorkchester #102  
Houston TX 77079

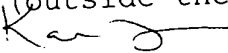
Re Application of  
Zhang, Thwin, Wu and Cho  
Application No. 08/975,519  
Filed: November 20, 1997  
For: Method for the Production and Purification of Adenoviral  
Vectors

Dear Dr. Cho:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

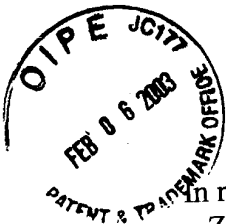
Telephone inquiries regarding this communication should be directed to the undersigned at (703)305-9285. Requests for information regarding your application should be directed to the File Information Unit at (703)308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703)308-9726 or 1(800)972-6382 (outside the Washington D.C. area).

  
Karin Tyson  
Senior Legal Advisor  
Special Program Law Office  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects

ARNOLD WHITE AND DURKEE  
PO BOX 4433  
HOUSTON TX 77210-4433

#35

PATENT



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CONSENT OF ASSIGNEE AGREEING TO CHANGE OF INVENTORSHIP

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

The assignee of U.S. Patent No. 5,658,730, Introgen Therapeutics, Inc., hereby agrees to the addition of Deborah Wilson and Lucetta Caston as co-inventors of said patent. Evidence of the assignment of the patent to Introgen Therapeutics, Inc. can be found at Reel 9220, Frame 0173.

By:   
Name: David L. Parker  
Title: Vice President, Intellectual Property  
Date: 1/29/03